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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/550,121

09/19/2005

Thomas S Riccobene

1825.70153

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24978 7590 11/13/2007  
GREER, BURNS & CRAIN  
300 S WACKER DR  
25TH FLOOR  
CHICAGO, IL 60606

EXAMINER

THOMAS, ALEXANDER S

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

11/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/550,121

**Applicant(s)**

RICCOBENE, THOMAS S

**Examiner**

Alexander Thomas

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16,17 and 24-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16,17 and 24-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Specification***

1. The amendment filed 10/22/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendment at page 2, line 18+, the phrase "lacks a discernable geometric pattern" is new matter. The original disclosure is direct to a pattern that is "not readily apparent" not one that lacks a geometric pattern; see page 8, lines 5-6 of the instant specification. Also, in the amendment to page 11, line 10+, the term "rock-like" is not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

#### ***Response to Arguments***

2. Applicant's arguments, see amendment filed 10/22/07, with respect to the rejections of claims 27 and 31 under 35 USC 112, have been fully considered and are persuasive in view of said arguments and the amendment to claim 31.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson 5,267,810. Applicant's arguments have been considered but are not deemed persuasive. Applicant argues that the reference does not disclose sides having an irregular configuration and submits that the sides in the reference are not jagged or rough hewn. However, the paver in the reference can be considered to be jagged in view of the fact that faces 16 and 20 extend out from face 18. Concerning the discussion of multiple units providing a honeycomb configuration, the instant claims are directed to a single unit, not multiple units, and the unit in the reference could be positioned with other similar units so as to not present a pattern if the units were laid in a random pattern on a substrate. Concerning claim 24, applicant argues that the placement of indicia on the spacers in the reference's product does not meet the standard for Official notice. However, the examiner disagrees. The definition of "indicia" is "an identifying mark, etc". Therefor, the placement of indicia on any object is obvious to one of ordinary skill in the art to identify the object. From this reasoning, it is clear that placement of indicia on any object is common knowledge in any art and capable of instant and unquestionable demonstration as being well-known. Regarding the discussion of claim 25, the instant claims and applicant's definition of irregular shaped sides do not preclude the sides from having some segments that are parallel. The irregularity in the side shown in the references product is a result of parallel faces 16 and 18, in combination with face 20.

5. Claims 17 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson as applied to claims 16, 24 and 25 above, and further in view of Hair 5,286,139. Hair discloses the equivalence of planar sides and introducing minor irregularities in the sides of his paver; see column 3, lines 17-21. It would have been obvious to one of ordinary skill in the art to provide the sides in the product of the primary reference with irregularities in view of the teachings in the secondary reference depending on the desired decorative and structural effects for a particular end use.

6. Claims 16, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolford 5,884,445 in view of Johnson. The primary reference discloses a paving element comprising irregular sides that are rotational images of one another; see Figure 1. The secondary reference discloses the use of spacers on paving elements; see column 2, lines 47-54. It would have been obvious to one of ordinary skill in the art to include spacers on the product of the primary reference in view of the teachings in the secondary reference to decrease the likelihood of blocks spalling or chipping.

7. Claims 17 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolford 5,884,445 in view of Johnson as applied to claims 16, 24 and 25 above, and further in view of Hair. Hair discloses the equivalence of planar sides and introducing minor irregularities in the sides of pavers; see column 3, lines 17-21. It would have been obvious to one of ordinary skill in the art to provide the sides in the product of the primary reference with irregularities in view of the teachings in the secondary reference depending on the desired decorative and structural effects for a particular end use.

***Double Patenting***

8. Claims 16, 17 and 24-33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 11/633,344. Although the conflicting claims are not identical, they are not patentably distinct from each other because the placement of spacers on paving elements is well-known in the art and it would have been obvious to one of ordinary skill in the art to put spacers on the element in the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Thomas whose telephone number is 571-272-1502. The examiner can normally be reached on 6:30-4:00 M-THUR.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:  
10/550,121  
Art Unit: 1794

Page 6

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Thomas/  
Primary Examiner  
Art Unit 1794